

REMARKS

Applicants have considered the January 30, 2006 Office Action regarding the above-identified application, and the claim amendments above together with these remarks are presented in a bona fide effort to respond to all issues raised in that Action. The claims have been amended to correct indefiniteness, to generally improve clarity, and to recite additional features so as to more clearly distinguish inventive subject matter over applied art. Unless specifically referenced in a traversal of an art rejection below, it is believed that revised claim language only provides improved definiteness or clarity and as such does not narrow the scope of any amended claim.

Care has been taken to avoid entry of new matter. Support for the amended claims should be readily apparent from the specification and drawings. All independent claims 11, 13, 15 and 17 now relate to the first embodiment (Fig. 1). Claims 13 and 17 further describe the management of the coupons use, which are supported by page 16, line 20 to page 17, line 25. Claims 15 and 17 relate to the case where the broadcasting or transmitting unit 20 and the service center 60 are integrated as described on page 9, lines 11 to 15. New claims 32 and 33 are supported by page 11, lines 11 to 25 of the specification.

It is believed that the amended claims are allowable, and Applicants respectfully request a prompt favorable reconsideration of this matter.

Definiteness

The Office Action included a rejection under the second paragraph of 35 U.S.C. § 112, in which it is asserted that several points in claims 11, 13, 15, 17 and 31 lack antecedent basis or are confusing. The claims have been amended above to address each allegedly indefinite point identified in the rejection.

For example, the rejection noted that the program or commercial message lacked antecedent basis in the paragraph reciting broadcasting or transmitting thereof, in each of claims 11, 13, 15 and 17. Each of claims 11, 13, 15 and 17 now earlier recites a broadcasting or transmitting unit for broadcasting or transmitting a program or commercial message, which should give ample antecedent basis for later references to “the program or commercial message” in the body of each independent claim and in several dependent claims.

With respect to claim 31, the indefiniteness rejection asserted that references to the receiver, each gender or each age zone lacked antecedent basis. Claim 31 depends from claim 13. References to the receiver in claim 31 should find antecedent basis in the initial recitation of “a receiver for receiving the program or commercial message via a network;” which now appears in the fourth paragraph of amended claim 13. As amended above, claim 31 recites that the shopping coupon issuance request is attached with audience information, and the audience information includes “gender and age zone.” It is respectfully submitted that this new recitation in claim 31 provides antecedent basis for the later claim reference to “each gender and each age zone.”

With respect to claim 31, the indefiniteness rejection also asserted that the claim was unclear as to “how the used coupon itself can include all of the claimed information.” The claim no longer states that the “coupon **includes** information on” various items. As amended, it should be clear that various information is processed in relation to (e.g. attached to or associated with) the coupon when requested and when used. For example, the shopping coupon issuance request has attached audience information, including gender, age zone and date and time when the shopping coupon is obtained by the receiver; and the used shopping coupon is attached with date

and time when the shopping coupon is used. It is respectfully submitted that the lack of clarity has been removed by the noted amendments to claim 31.

For the reasons discussed above, it is believed that the claim amendments above correct each alleged indefiniteness in claims 11, 13, 15, 17 and 31. Applicants therefore submit that all pending claims particularly point out and distinctly claim subject matter Applicants believe they have invented, and therefore request that the Examiner withdraw the indefiniteness rejection.

Patentability

The Office Action also included an art rejection, although the Action is somewhat contradictory as to what claims that rejection addressed. The initial statement at the top of page 3 of the Detailed Action lists the formerly pending set of claims 11-27 some of which were cancelled prior to the Action. The initial statement did not list then pending claims 28-31. From the subsequent explanation of the rejection, however, it appears that the Examiner intended to reject all of the claims that were actually pending as of the date of the Action (11, 13, 15, 17, 20, 21 and 23-31). The art rejection, under 35 U.S.C. §103, alleges that the claims (presumably claims 11, 13, 15, 17, 20, 21 and 23-31), are unpatentable over U.S. Patent No. 5,287,181 to Holman in combination with U.S. Patent No. 4,674,041 to Lemon et al. (hereinafter Lemon) and U.S. Patent No. 6,282,713 to Kitsukawa et al. (hereinafter Kitsukawa).

The art rejection is traversed. The independent claims have been amended to more clearly distinguish over the applied combination of documents, and it is respectfully submitted that all of the pending claims now patentably distinguish over that art. A detailed explanation of patentability of the claims follows.

The claims now pending in this application include aspects implemented on the program/commercial message transmission side relating to the coupon, with linking to the

program or the commercial message as “history.” As exemplified in the disclosed first embodiment, the transmission side sends coupon information with the program or commercial message and that side (broadcasting or transmission unit or service center) issues and transmits the coupon in response to a request from the receiver of the program or the commercial message. The “history” may track number of issuances of the coupon, and/or the “history” may track number of uses of the coupon. At least in part, the history is based on the request for issuance of the coupon received at the broadcasting/transmitting unit or the service center. There are several different claim distinctions that flow from this disclosed exemplary arrangement.

A. ‘History Means’

Each of the independent claims expressly recites a “history storing means.” In claims 11 and 13 the history storing means is an element of the service center. In claims 15 and 17 the history storing means is an element of the broadcasting or transmitting unit.

Holman (US patent 5,287,181) shows the home unit 1 which generates coupons in response to encoded coupon-related data received in a television signal. The home unit 1 displays the message such as “\$1 discount on 6-pack of Coke®” with the commercial on a TV screen 38. If the audience participant pushes the coupon button 11, the home unit 1 stores the coupon-related data for each commercial in the internal memory. Later, when the audience participant pushes the load coupon button 19, the home unit 1 transfers the coupon to a magcard for redemption (Column 6, lines 34-64). In Holman, the home unit 1 is assumed to be placed on the top of a television receiver (Column 5, lines 41-42). Hence, Holman’s home unit is set at the television signal receiving side, which most closely corresponds to the “receiver” mentioned in Applicants’ independent claims. Patent Figs. 8 and 9 show terminal systems for coupon redemption. The Holman patent does not show any device corresponding to the “history storing

means,” in a service center or in a broadcasting or transmitting unit as required by the pending independent claims. The rejection relies on Lemon and Kitsukawa, but those secondary documents are insufficient to lead to a combination with Holman that would satisfy Applicants’ claims, as discussed more fully below.

Each of independent claims 11, 13, 15 and 17 specifies that the history storing means is for storing a history including the identifier of the shopping coupon and information on the program or commercial message, that is to say the program or commercial message with which the coupon information was sent, based on the shopping coupon issuance request. Lemon (US 4,674,041) does not disclose or fairly teach such a history storing means. The rejection cites Lemon (US patent 4,674,041) for alleged teachings to track issuances of coupons and redemptions of coupons. The Lemon patent shows a standalone terminal for issuing coupons and a host to monitor and control the number of coupons issued and redeemed. Lemon, however, does not teach broadcast or transmission of coupon information with a program or commercial message or any form of correlation of coupon functions to a transmitted message for a program or commercial. Hence, addition of the alleged teachings to track issuances of coupons and redemptions of coupons from the Lemon patent to the Holman system would still not lead to a system having a service center or a broadcasting or transmitting unit that includes history storing means for storing a history that includes the identifier of the shopping coupon and information on the program or commercial message, that is to say the program or commercial message with which the coupon information was sent, based on the shopping coupon issuance request. Since, there is no storage of a history of the type specified in the claims, there is no associated use of the history as recited in the claims.

The Examiner clearly recognizes that Holman and Lemon are not sufficient to teach the systems of Applicants' claims. The art rejection adds the new citation Kitsukawa (US patent 6,282,713) for an alleged teaching of storing coupon identifiers and broadcast content information. However, such an addition to Holman and Lemon still would not result in a combination that includes the history storage and associated processing of the issuance or use data as in Applicants' claims.

The claims recite different uses of the history, albeit on the side of the broadcasting/transmitting unit and/or of the service center. Each independent claim requires that the broadcasting or transmitting unit comprises broadcasting/transmitting management means for determining a period, a number of times or a fee, for the broadcasting or transmitting of the program or commercial. In claims 11 and 15, the determination is based on the number of issuances of the shopping coupon. In claims 13 and 17, the determination is based on number of uses of the shopping coupon. The storing of coupon identifiers and broadcast content information actually taught by Kitsukawa would not provide the history of issuance, the history of usage or the attendant processing of issuance or usage data in the manner clearly recited to varying degrees of scope in Applicants' independent claims.

The receiver may store program data with coupon data on the removable storage medium (Kitsukawa, column 11, lines 48 to 54). The merchant may provide data to a collection center (column 11, line 62, to column 12, line 9); or the collection center may obtain data from the viewer's system (column 11, lines 9 to 13). As discussed in column 12, lines 9 to 20, Kitsukawa suggests that data corresponding to the television program is electronically transferred to a collection center, generally for "use as statistical television data." However, Kitsukawa is silent on the "statistical" usage of such collected data. Hence, Kitsukawa provides no specific

suggestion to determine the number of the coupon issuances and/or to determine the number of the actual uses of the coupon, in relation to any particular program or commercial message. Kitsukawa would not lead an artisan to develop a history of coupon issuance or coupon use in relation to the program or commercial with which the coupon information was sent to the receiver, to the different degrees recited in the independent claims now pending in this application.

Since Kitsukawa does not suggest analyzing data to determine how many of the coupons are issued or how many of coupons are used in relation to the program or commercial, Kitsukawa likewise fails to disclose the broadcasting/transmitting management means for determining a period or number of times or a fee for the broadcast or transmission of program or commercial, based on either issuances or number of uses of the shopping coupon as recited to different degrees in Applicants' claims.

For the reasons outlined above, the applied combination of Holman, Lemon and Kitsukawa does not actually satisfy all of the recitations of any of the independent claims; and all of the pending claims patentably distinguish over the applied art.

B. Coupon Issuance Technique in Support of History

In the first embodiment disclosed in the present application, the service center issues the coupon in response to a coupon issuance request from the program receiver, and the service center can count the number of the issued coupons. Integration of service center functions and functions of the broadcasting or transmitting unit are described on page 11, lines 11 to 25 of the specification.

Each of independent claims 11, 13, 15 and 17 specifies that the service center or the broadcasting/transmitting unit includes means for receiving a request for coupon issuance, means

for transmitting or for issuing the coupon and means for storing a history including the identifier of the shopping coupon and information on the program or commercial message based on the received shopping coupon issuance request. As such, each of the independent claims now require receiving the shopping coupon issuance request from the program receiver; transmitting or issuing the coupon back to that program receiver; and storing a history including the identifier of the shopping coupon and information on the program or commercial message, that is to say the program or commercial message with which the coupon information was sent, based on the shopping coupon issuance request.

It is respectfully submitted that the applied art does not fairly suggest such a sequence of operations to issue a coupon following transmission/broadcast of coupon information with a program or commercial. In fact, the two applied documents that actually disclose communication of coupon information with a program or commercial teach away from the claim issuance and history recording functions. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be ... led in a direction divergent from the path that was taken by the applicant...” *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

The Lemon patent shows a standalone terminal for issuing coupons and a host to monitor and control the number of coupons issued and redeemed. Lemon, however, does not teach broadcast or transmission of coupon information with a program or commercial message or any form of correlation of coupon functions to a transmitted message for a program or commercial. The other documents, Holman and Kitsukawa, teach transmission of coupon information with video content. However, neither Holman nor Kitsukawa teach that a request for actual issuance is received at a center or a transmitting/broadcasting unit, then transmitting or issuing the coupon

and recording the history based on the received shopping issuance request. Both Holman and Kitsukawa teach the contrary approach, to capture or download the coupon information from a video content transmission so as to store/issue the coupon at the receiver location.

Holman (US patent 5,287,181) shows the home unit 1 which generates coupons in response to encoded coupon-related data received in a television signal. The home unit 1 displays the message, and if the audience participant pushes the coupon button 11, the home unit 1 stores the coupon-related data for each commercial in the internal memory for later off-load to a mag card. Similarly, Kitsukawa teaches that coupon information is received along with broadcasts of associated television programs (column 10, lines 37 to 43), and data for a selected coupon (from the television broadcast) is loaded onto the removable recording medium (Fig. 8 and discussion thereof in columns 10 and 11). Teachings to capture the coupon information directly from program broadcasts (both Holman and Kitsukawa) would strongly encourage a skilled artisan to use such a technique to issue coupons, without a coupon issuance request received at a service center or transmitting/broadcasting unit and without a subsequent transmission or issuance of the actual coupon from the service center or transmitting/broadcasting unit.

In techniques such as actually taught by Holman and Kitsukawa, where the receiver issues the coupon based on data captured from the broadcast transmission (with the program content), the issuer has no immediate knowledge of the coupon issuance. It may be difficult to track issuances. In Applicants' first embodiment, the coupon issuance request received at the service center or broadcasting/transmitting center provides accurate issuance information at the time of issuance. The issuance information may be correlated with the program or commercial in the history that is kept based on the shopping issuance request. In the claims, the history is

based on the coupon issuance request, that is to say the request that the center or broadcasting/transmitting unit receives from the receiver via the network. Lemon does not suggest such a history correlate to a program or commercial, and the Holman and Kitsukawa documents teach away from the claimed approach. Hence, the three documents would not fairly suggest the claimed combination of information broadcasting/transmitting means, request receiving means, coupon transmitting or issuing means in the broadcasting or transmitting unit or in the service center, and the associated history means, as recited in the amended independent claims. It is respectfully submitted that the claimed system would not have been obvious, in the legal sense of 35 U.S.C. §103, over Holman, Lemon and Kitsukawa.

For this additional reason, the claims patentably distinguish over the applied combination of Holman, Lemon and Kitsukawa.

Conclusions

For the reasons explained above, it is believed that all pending claims are now definite and patentable over the most recently applied art. Hence, all rejections set forth in the latest Office Action should be overcome, and the case should not be in condition for allowance. Applicants respectfully request a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the January 30, 2006 Office Action. However, if any further issue should arise that may be addressed in an interview or by an Examiner's amendment, it is requested that the Examiner telephone Applicants' representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of

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this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Keith E. George", written over a horizontal line.

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